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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,776	01/18/2002	Christopher R. Jenney	A02P1008	4220
36802	7590	11/24/2004	EXAMINER	
PACESETTER, INC. 15900 VALLEY VIEW COURT SYLMAR, CA 91392-9221			GETZOW, SCOTT M	
			ART UNIT	PAPER NUMBER
			3762	
DATE MAILED: 11/24/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

05

Office Action Summary	Application No. 10/052,776	Applicant(s) JENNEY ET AL.	
	Examiner Scott M. Getzow	Art Unit 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-137 is/are pending in the application.
 4a) Of the above claim(s) 133-137 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-132 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4,7,16,19-26,29,30,32,33,40,43-50,96-104,109-112 are rejected under 35 U.S.C. 102(b) as being anticipated by Lieber et al (5029585).

Lieber shows a multi-lumen lead that includes electrodes 71 and 73 that are made from conductive polymer. The placement of the electrodes, such as in the superior vena cave or coronary sinus is considered to be intended use, not a structural limitation. Further, the electrodes of Lieber would be sufficient to deliver low-level cardioversion pulses, and thus would be adequate in size.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-13,36,37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lieber et al in view of Soukup et al (5609622).

Soukup teaches a conductive polymeric layer 15 which is helically wound around the lead. To make the electrodes of Lieber into a helical form would have been

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obvious since such would greatly increase the effective length of the electrode and therefore its ability to stimulate tissue.

5. Claims 5,6,17,18,27,28,31,34,35,41,42,107,108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lieber et al.

To have redundancy in the conductors would have been obvious since such would provide a back up in case a conductor failed for some reason. Further, to use different lumens for the different conductors would provide increased insulation. Also, intrinsically conductive polymers are well known in the art, and the ordinarily skilled artisan would be expected to be familiar with them. Still further, the use of coiled conductors, in place of cable conductors, would have been obvious since such provides increased strength and flexibility.

6. Claims 51-76,79-95,113-124,127-132 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lieber et al in view of Strandberg et al (5476496).

Strandberg shows the use of a tip electrode 8. Such electrodes are common in the art since they provide the ability to stimulate or sense at an important location in the patient's heart. Thus, it would have been obvious to use such with the device of Lieber.

7. Claims 14,15,38,39,105,106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lieber et al in view of Laske et al (6801809).

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Laske teaches enhancing the bond between the conductor and electrode; see col. 2, lines 26-51. To utilize bonding enhancement with the device of Lieber would have been obvious since a stronger connection between conductor and electrode would lessen the chances of lead failure.

8. Claims 77,78,125,126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lieber et al and Strandberg et al, and further in view of Laske et al.

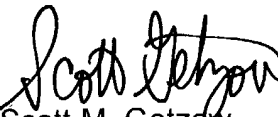
It would have been obvious to use the bonding means of Laske for reasons mentioned supra.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott M. Getzow whose telephone number is (571) 272-4946. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Scott M. Getzow
Primary Examiner
Art Unit 3762

Smg